

Atty. Docket No. 2003-0025-02
USSN 10/631,349

Remarks

The Examiner has made a restriction requirement as to eight groups of claims I-VIII, respectively I (Claim 1); II (Claims 2-4); III (Claims 5-20); IV (Claim 21); V (Claim 22), VI (Claim 23); VII (Claims 24-57); VIII (Claims 58-91).

Applicants respectfully traverse the Examiners' restriction requirement as to Groups I-III, VII and VIII, and hereby cancel the claims in Groups III-VI.

Applicants assert that the claims in Groups I-II, VII and VIII do not relate to independent or distinct inventions for purposes of 35 U.S.C. §121.

The criteria for requiring a restriction are that the inventions in the different groups of claims be "independent ... or distinct" and also that there "be a serious burden on the examiner" (M.P.E.P. §803) The same section of the M.P.E.P. notes that the Examiner may make a *prima facie* case for "serious burden" if the Examiner "shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search"

The Examiner has done none of these. In fact the Examiner has placed each of the eight groups of claims I-VIII in precisely the same class and subclass 372/54.¹ The Examiner has not stated that the field of search would be overly extensive, and past history of applicant's assignee's patent applications in this field have indicated that searches in several of the subclasses of Class 372 have not been overly extensive or burdensome.²

The claims in Groups I-II, VII and VIII all relate in subject matter, i.e., to a gas discharge laser system under Class 372, and more particularly to a multiple laser system, i.e., an oscillator laser seeding an amplifier laser, which generally have been primarily

¹ Actually the classification should probably be 372/55 or 372/57, where virtually all of applicants' assignee's prior patents relating to either multi-chamber gas discharge lasers or pulse power system voltage and/or timing control for such laser systems have been classified in the past. Class 372/54 is under liquid coherent light sources. Even the fact that such prior patents have been primarily classified in 372/55 for dual chambered gas discharge laser systems (e.g., 6,690,704, 6,625,191, 6,618,421, 6,567,450, 6,549,551, and 6,630,174) and 372/57, 25 or 28 for pulse power system voltage and/or timing control (e.g., 6,553,049, 6,327,286, 5,982,795, 5,936,989, RE38,054) and secondarily classified in each case in a variety of subclasses including 55, 57, 58, 38 and 25, and the field of search have involved mostly those subclasses along with a few others, there have been very few restriction requirements in the past for patent applications containing claims like those of the present application.

² See note 1.

Atty. Docket No. 2003-0025-02
USSN 10/631,349

classified in Class 372/55 or at least secondarily classified there when, e.g., the claims have related to specific aspects of the magnetic circuits in the pulse power system (372/38) of other features, e.g., 372/25. This has not resulted in restriction requirements in the past.

The claimed invention here is the same. Even more specifically all of the remaining claims relate to a control system or method for "controlling the timing of the release of the energy stored on the respective master oscillator and power amplifier charging capacitors in order to control the timing of the applications of the electrical gas discharges pulse across the respective master oscillator and power amplifier electrodes," as recited in claims 1. Claims 2-4 recite essentially the same thing, with somewhat different approaches to how this timing is to be accomplished. Claims 24-57 and 58-91 relate to the same exact subject matter "a gas discharge laser timing control system for a two chambered gas discharge laser system," with claims 58-91 reciting the method of operation of the apparatus as recited in claims 24-57.

Applicants respectfully assert that the claims in Groups I-II, VII and VIII are not patentable over each other and also that the claims in Groups VII and VIII are even more clearly not patentable over each other. In the case of the claims in Groups VII and VIII clearly if two patents issued for the apparatus on the one hand and the method of operating that apparatus then two patent would issue for the same invention and at least a terminal disclaimer would be required.

Applicants submit that at a minimum, with respect to the claims in Groups VII and VIII there is neither a "different and distinct" invention nor an undue burden of examination on the Examiner. Applicants also believe that the same timing control method and apparatus is recited in the claims in Groups I-II as well.

Applicants provisionally elect the claims in Group VII for examination, but respectfully submit that the inventions in Groups I-II and VIII should be examined as well.

The Examiner has stated that the claims in Groups I, II and VII³ are claimed subcombinations, disclosed as usable together." M.P.E.P. §806.05(d) Applicant submits that these claims in Groups I, II and VII are, rather, claims to different species of the

³ The Group IV claim has been cancelled.

Atty. Docket No. 2003-0025-02
USSN 10/631,349

multiple laser timing control apparatus for controlling the timing of the gas discharge in the amplifier portion of the laser system after the occurrence of the gas discharge in the oscillator portion of the laser system. In such an event, if the test for distinctiveness is not met for either a plurality of subcombinations or a plurality species, then restriction is not proper. M.P.W.P. §806.05 (d) A reasonable number of species may be claims in a single application. M.P.E.P. §806.04(a)

With respect to the distinctiveness of claims directed on the one hand to an apparatus and on the other hand to a method of utilizing that very same apparatus, i.e., the claims in Groups VII and VIII, then these claims can be shown to be to a distinct invention only if:

(A) ... the process *as claimed* can be practiced by another materially different apparatus or by hand; or

(B) ... the apparatus *as claimed* can be used for another and materially different process. M.P.E.P. §806.05(e)

Applicants respectfully submit that neither of these conditions exist for the apparatus of claims 24-57 and the corresponding method of claims 58-91. Applicants respectfully disagree, at least with respect to the claims of Groups VII and VIII that the unpatentability of the one is determinable independently of the other.

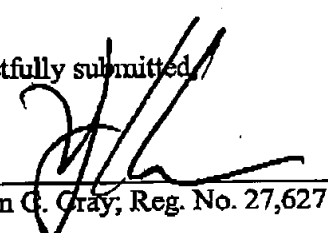
For the above stated reasons Applicants respectfully request that the Examiner withdraw the restriction requirements for the claims in Groups I, II, VII and VIII and examine the claims in Groups I, II, VII and VIII and at a minimum the claims in groups VII and VIII together.

Atty. Docket No. 2003-0025-02
USSN 10/631,349**Conclusion**

The Examiner has made a restriction requirement as to eight groups of claims I-VIII, respectively I (Claim 1); II (Claims 2-4); III (Claims 5-20); IV (Claim 21); V (Claim 22), VI (Claim 23); VII (Claims 24-57); VIII (Claims 58-91). The Claims in Groups III-VI have been cancelled. Applicants have provisionally elected the claims in Group VII for examination but have traversed the Examiner's restriction requirement for the claims in Groups I, II, VII and VIII and respectfully request that the Examiner withdraw the restriction requirements for the claims in Groups I, II, VII and VIII and examine the claims in Groups I, II, VII and VIII, or at a minimum examine the claims in groups VII and VIII together.

Applicants do not believe that any fees or charges are due for the above captioned application but in the event that there are, the Commissioner is hereby authorized to charge the Deposit Account of applicants' assignee Cymer, Inc. Deposit Account No. 03-4060 for any such amount(s).

Respectfully submitted,


William G. Gray, Reg. No. 27,627

December 2, 2004
Cymer, Inc.
Legal Dept., M/S 4-2C
17075 Thornmint Court
San Diego, California 92127-2413
Telephone: 858-385-7185
Facsimile: (858) 385-6025